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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,275	11/25/2003	Anthony Krallman	51548/THD/K425	2958
23363	7590	04/21/2004	EXAMINER	
CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,275

Applicant(s)

KRALLMAN, ANTHONY

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 11/25/2003 – application papers filed.

This application is a DIVISIONAL of 10/246,867.

Claims 1-20 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 8, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamada. As to claim 1, note head (7) including face (13), hosel (5) and a shaft (3). A hollow chamber formed by hole (17) includes insert material (21) that may be plastic material and thus capable of dampening impacts. As to claim 2, Figure 6 clearly shows that the hollow chamber (17) is formed within the sole portion (11). As to claim 6, the head and shaft are formed of metal material. As to claim 8, there is clearly some "depth" in the dimension of the hollow chamber. As to claim 11, here again, the head in Hamada includes a hosel and shaft as well as a hollow chamber in the sole

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within which an insert element is inserted. As to claim 15, the club face clearly includes a lofted portion with respect to the horizontal.

Claims 1, 2, 6, 8, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang. As to claim 1, note head (1) including face (106), hosel (11) and a shaft (12). A hollow chamber formed by hole in the sole (101) includes shock-absorbing insert material (104) that and thus is capable of dampening impacts (col. 2, lines 40-65 and Figure 5). As to claim 2, Figure 5 clearly shows that the hollow chamber is formed within the sole portion (101). As to claim 6, the head and shaft are formed of metal material. As to claim 8, there is clearly some "depth" in the direction of the face for the hollow chamber. As to claim 11, here again, the head in Chang includes a hosel and shaft as well as a hollow chamber in the sole within which an insert element is inserted. As to claim 15, the face is clearly shown as having a loft.

Claims 1, 16, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi. As to claim 1, note club head (12) having hollow chamber (22) within which insert elements (28) are inserted. As to claim 16, the club head appears to be of the metal wood-type, i.e., a driver (col. 4, lines 9-18). As to claim 17, the hosel (shown, but not numbered) connects the shaft (16) to the head (12). As to claim 19, note Figure 7 showing a cross-section through the club head and showing a lofted face surface (48). As to claim 20, note that iron beads (i.e., lead shot) is used as the insert element (col. 4, lines 62-65).

Claims 1, 2, 6, 11, 12, 15, 16, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi. As to claim 1, club head (10) includes a hollow

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chamber (16b) that includes insert elements (17) disposed therein. Note hosel (11) for receiving a shaft. As to claim 2, the hollow chamber includes a portion of the sole (Figures 1 and 2). As to claim 6, the golf club may comprise metal material (col. 2, lines 65-68). As to claim 11, here again, the Kobayashi device includes a club head having a hosel and a shaft, with a hollow chamber (16b) at least partially extending into the sole portion and a plurality of insert elements (17) disposed within the hollow chamber. As to claim 12, the hollow chamber (16b) is sealed at one end and capped at an opposite end (Figures 1 and 4). The capped end enables the user to selectively adjust the amount of insert elements (17). As to claim 15, Figure 2 clearly shows a lofted face. As to claim 16, the golf club may be fabricated as a metal wood-type club head. As to claim 17, note that Kobayashi does include a hosel and shaft (Figures 1 and 2). As to claim 19, here again note Figure 2 showing a lofted club face.

Claims 1, 2, 6, 8, 11, 12, 13, 16, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wargo. As to claims 1, 2, 6 and 11, note the embodiment shown in Figure 6 along with the discussion in col. 6, lines 43-53, wherein Wargo discloses a club head having a striking face, hosel, shaft and a sole portion, with the sole portion having a hollow chamber within which metal particles (69) are located. Specific to claim 8, there is clearly some depth associated with the hollow chamber. As to claims 16, 17, 19 and 20, reference is made to Figure 9 and its accompanying description detailing a metal wood-type club head having a hollow chamber within which an insert element is fitted. From the earlier discussion in Wargo, it is clear that metal pellet material(s) may be employed with the Figure 9 embodiment.

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Claims 1, 4, 5, 6, 8, 9, 10, 16, 17, 18, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAtee in view of Antonious. The patent to McAtee differs from the claimed invention in that McAtee fails to disclose a hosel as well as the specific claimed % weight of the insert elements. Antonious shows it to be old in the art to provide a metal wood-type club head with a protruding hosel ((12) into which a shaft is to be inserted or alternatively without a traditional hosel, so that the shaft may be directly attached to the head. See Figures 1-6 as compared with Figures 8-12 in Antonious. See col. 4, lines 13-48 in Antonious describing the hosel and hoselless designs. Antonious notes that the traditional hosel (Figure 7A) provides a strong and stable connection between the shaft and the head. In view of the patent to Antonious, it would have been obvious to modify the device in the cited art reference to McAtee by including a hosel, the motivation being to create a strong bond between the shaft and the head. With respect to the claimed % weight of the insert elements, as required by claims 4, 5 and 18, note that between 25% and 75% of the internal area of the chamber may be filled with lead shot (col. 3, lines 42-52). Though not specifying that 15% - 45% of the club head weight is occupied by the lead shot, it seems logical that at least 10% and moreover at least 15% of the head weight in McAtee would have included the lead shot if, for example, 75% of the chamber's internal area were to have been filled with lead shot, considering in addition that the head in McAtee may comprise metal or plastic material for the shell. This would appear to flow logically from common sense. With respect to the remaining limitations and concerning claims 6 and 17, McAtee comprises a head and shaft formed of metal material. As to claim 8, Figure 5 clearly shows the

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chamber within the head extending with some depth in the direction of the plane containing the face. As to claim 20, the insert elements (30) in McAtee are detailed as lead shot.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAtee in view of Shearer. McAtee does not appear to show a separate tube attached to the shell and face portions. Rather, the internal chamber in McAtee is detailed as a void in the head. Shearer shows it to be old in the art to include a tube within a hollow metal shell club head, with the tube carrying a weight member. The tube may be cast integrally with the head or attached separately thereto (col. 3, lines 26-36). It would appear that the manner of attaching the tube to the head would have depended upon the manufacturing techniques available to the skilled artisan at the time of the invention. Furthermore, the claimed requirement that the face be welded to the shell portion would not appear to add any structure to the invention, as the final club head product would not differ in appearance or function with the face being otherwise attached to the head. For example, the face could have been attached to the shell via adhesive or formed integrally with the shell. In view of the patent to Shearer and the above reasoning, it would have been obvious to modify the device in the cited prior art to McAtee by attaching a tube within the hollow shell and thereafter attaching a face to the shell and the tube, the motivation being to provide a convenient and economical means for manufacturing the club head. As to claim 7, both McAtee and Shearer show metal wood-type club heads.

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Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Hamada, Chang, or Kobayashi. None of the prior art devices to Hamada, Chang or Kobayashi specifically disclose metal pellets and the specific % weight of the insert element. However, note that each prior art reference is concerned with shifting the center of gravity and suggests that either the material of the insert elements or the amount of the insert elements may be varied to suit the particular needs of a golfer. See, for example, col. 6, lines 26-34 in Hamada. See, for instance, col. 2, line 66 through col. 3, line 15 in Chang. Note col. 1, lines 62-68 in Kobayashi. It would have been obvious to modify any one of the devices in the prior art to Hamada, Chang or Kobayashi to include metal pellets simply to provide an alternative material with which to fill the hollow chamber in the head. Additionally, it would have been obvious to include the claimed % weight of insert elements in order to provide a desired weight distribution for the club head.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the weighted chamber in Sommer. Beasley shows an internal chamber filled with a gel material. Note chamber (67) in Capelli. Morrison shows the attachment of a shaft to the head with or without a hosel assembly. Sun discloses weights in the sole portion, of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
April 15, 2004